

IN THE DRAWINGS:

A Substitute drawing sheet is enclosed for FIG. 5 to replace the original drawing sheets filed with the application. No new matter has been added. Specifically, the following amendments have been made:

“MODE” is deleted from step ST11

“DEFENET MODE” is replaced with “SELECT DEFAULT USER” in step ST12.

Step ST13 is amended to recite “TRANSMIT EXPERIENCE INFORMATION OF THE TOY TO THE CYBER CHARACTER ACCORDING TO THE SELECTED USER.”

Step ST14 is amended to recite “TRANSMIT EXPERIENCE INFORMATION OF THE CYBER CHARACTER TO THE TOY.”

## REMARKS

Applicant graciously acknowledges the telephone interviews with the Examiner on July 27 and August 16 and 19, 2005. With this paper, Applicant has attempted to address the issues raised in the interviews. Applicant has studied the Office Action dated May 11, 2005, and has made amendments to the claims. Claims 1-18 are pending. Claims 1, 13 and 18 are independent claims. Claims 1, 6, 12, 13 and 18 have been amended. No new matter has been entered. It is submitted that the application, as amended, is in condition for allowance. Reconsideration and reexamination are respectfully requested.

### Amendments to Drawings

An amendment has been made to the FIG. 5 in response to objections by the Examiner. No new matter has been added as the amendment has support in the application as originally filed.

### Amendments to the Specification

Amendments have been made to the specification at page 7 in response to an objection by the Examiner. No new matter has been added as the amendments have support in the specification and drawings as originally submitted.

### Amendments Claims

The amendments to the claims are intended to correct typographical errors and to more clearly disclose the invention and are not related to patentability.

### Assertion of New Matter

The Examiner asserted that the prior response added new matter to claim 18. Specifically, the Examiner asserted that the amendment to the second limitation of claim 18, such that the claim recites "selecting a user mode to identify the user of the toy," resulted in new matter. Applicant respectfully disagrees with the Examiner's assertion and respectfully submits that support for the limitation may be found in the specification as originally filed at page 9, ll. 2-4 and FIG. 5, step ST11.

### Objection to Drawings

The Examiner objected to FIG. 5. Specifically, the Examiner asserted the following:

The phrase “USER SELECTION MODE” in step ST11 should be replaced with the phrase “SELECTION MODE.”

The text of step ST 13 should be replaced with “TRANSMIT THE TOY’S CURRENT MODE EXPERIENCE TO A CYBER CHARACTER.”

“TRANSMIT A CYBER CHARACTER’S EXPERIENCE TO THE TOY” was indicated with no further details regarding the specific objection made by the Examiner. Applicant has respectfully assumed that the Examiner is asserting that the text of step ST14 should be replaced with the indicated text. If the Examiner intended to suggest some other amendment, Applicant will respectfully consider any further comment by the Examiner.

With this paper, FIG. 5 has been amended to more clearly disclose the invention, specifically at steps ST11 – ST14. However, the amendments are slightly different than those suggested by the Examiner. Support for the amendments may be found in FIG. 5 and the specification and as originally filed, specifically at page 9, ll. 2-20.

Step ST 11 has been amended to delete the word “MODE” as it is not a “MODE” but rather a “USER” that is selected, as evidenced by the recitation of “USER 1, USER 2, ...” Step ST 12 has been amended to add the word “SELECT” and replace the word “MODE” with the word “USER” as it is a “DEFAULT USER” rather than a “DEFAULT MODE” that is selected. Step ST 13 has been amended to add the word “TRANSMIT” and to indicate that the “EXPERIENCE INFORMATION” is transmitted to the “CYBER CHARACTER” according to the “SELECTED USER” as the information is transmitted according to the “user” selected in step ST 11 or ST 12. Step ST 14 has been amended to add the word “TRANSMIT” and to indicate that the “EXPERIENCE INFORMATION” is transmitted to the “TOY.”

It is respectfully submitted that the grounds for objection have been overcome and it is respectfully requested that the Examiner withdraw the objection.

### Objections to Specification

The Examiner objected to the specification due to informalities. Specifically, the Examiner asserted that the word “ID” at line 12 of page 7 should be replaced with “ID (identification)”

With this paper, the specification has been amended as suggested by the Examiner. It is respectfully submitted that the ground for objection have been overcome and it is respectfully requested that the Examiner withdraw the objection.

#### Claim Objections

The Examiner objected to claims 1, 4, 6, 12, 13 and 18 due to informalities. Specifically, the Examiner asserted the following:

The word “computerized” in claims 1 and 13 should be replaced with the phrase “computer-implemented.”

The word “claim” in claim 4 should be replaced by the phrase “claim 1.”

The phrase “to for” in claim 6 should be replaced with the word “to.”

The word “replace” in claim 12 should be replaced by the word “replaced.”

The word “boy” in claim 13 should be replaced by the word “toy.”

The phrase “method implemented in a computerized toy” in claim 18 should be replaced with the phrase “computer-implemented method n a toy.”

The phrase “the user of” in claim 18 should be replaced with the phrase “the mode of.”

The phrase “default user” in claim 18 should be replaced with the phrase “default mode.”

The phrase “the user mode” in claim 18 should be replaced with the phrase “a mode.”

The phrase “selected user” in claim 18 should be replaced with the phrase “selected mode.”

With this paper, claims 4, 6 and 12 have been amended as suggested by the Examiner. Furthermore, claim 13 has been amended to replace “boy” with “toy” as suggested by the Examiner.

With respect to the objection to the word “computerized” in claims 1, 13 and 18, it is respectfully noted that those claims have been amended with this paper to delete the word “computerized.” It is respectfully submitted the objections are now moot with respect to the word “computerized” and it is respectfully requested that the objections be withdrawn.

With respect to the objection to the phrase “the user of” in claim 18, it is respectfully noted that claim 18 has been amended with this paper to recite “selecting a user of the toy.” Support for the amendment may be found in FIG. 5 and the specification and as originally filed, specifically at page 9, ll. 2-20 and by the recitation of “USER 1, USER 2,” in step ST11.

With regard to the objection to the phrase “the user mode” in claim 18, it is respectfully noted that claim 18 has been amended with this paper to replace “the user mode” with the phrase “a user.” It is submitted that the phrase “a user” is correct in view of the other amendments to the claim and previous remarks.

With regard to the objections to the phrases “default user” and “selected user” in claim 18, it is respectfully submitted that those phrases are correct in view of the other amendments to the claim and previous remarks.

It is respectfully submitted that the grounds for objection have been overcome and it is respectfully requested that the Examiner withdraw the objections.

### § 103 Rejections

It is further respectfully noted that, in the Office action, the Examiner asserted Gabai et al. by reference to paragraph numbers of the asserted text without any indication of the text that is asserted, while the issued Gabai et al. reference is in a column/row format. During the telephonic interview on August 19, 2005, the Examiner indicated the columns and rows corresponding to the paragraph references that were asserted in the Office action. Therefore, the discussion with respect to Gabai et al. will refer to both the paragraph references asserted in the Office action and the corresponding column/row indicated by the Examiner. However, any additional portions of Gabai et al. that were not cited in the office action will be referenced only with respect to the corresponding column and row.

Claims 1-4, 7, 10 and 13 were rejected under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as unpatentable over Gabai et al. (“Gabai” U.S. Pat. No. 6,773,344) in view of Nakamura et al. (“Nakamura” “Play and Learning in the Digital Future” (Nov.-Dec. 1989)) in view of Yang et al. (“Yang” “Interactive artificial life based on behavior and perception in a virtual environment” (30 July – 2 Aug. 2000)) and in further view of Olafsson (“Games on Networks” (Oct. 1997)). This rejection is respectfully traversed.

### Combination of Olafsson with Gabai, Nakamura and Yang references is Improper

The Examiner asserted in the Office action, at pages 4- 5, that the Gabai invention modified by the teachings of Nakamura, Yang and Olafsson renders the claimed invention obvious. The Examiner further asserted that the motivation to modify Gabai, Yang and

Nakamura by the teachings of Olaffson is “applying a set of strategies (Olaffson, page 1556, section I, paragraph 2)” to direct “autonomous characters (Nakamura)” to interact “with a dog character in a mixed environment (Yang).” Applicant respectfully disagrees with the Examiner’s interpretation of Olaffson and respectfully asserts that the combination of references is not proper.

First, it is respectfully submitted that Olaffson is directed to non-analogous art with respect to Gabai, Nakamura and Yang. It is further respectfully submitted that Olaffson has no relationship to a computerized toy, cyber community, cyber character or user of a toy, as recited in the claims of the present application.

It is respectfully noted that the criteria for determining whether prior art is analogous is twofold. First, one must determine whether the art is from the same field of endeavor, regardless of the problem addressed. Second, if the reference is not within the field of the inventor’s endeavor, one must determine whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. In re Deminski, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986); In re Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979).

It is respectfully noted that Gabai is directed to “computerized toys” and, specifically, to allowing “toy owners who do not have available a personal or other local computers to operate interactive toys.” Col. 1, line 14 and col. 3, ll. 31-39. It is further respectfully noted that Nakamura is directed to “video games” and, specifically, to “children’s play and learning” by using “games and toys” as “communication tools.” Abstract. It is further respectfully noted that Yang is directed to “cyber characters ... inhabiting a virtual world” and, specifically, to “a cyber-character system designed to provide users with a realistic feeling of an artificial life.” Abstract. Moreover, it is respectfully noted that the present invention is directed to “a toy learning apparatus using a cyber community” and, specifically, to the disadvantages of a conventional computerized “intelligent toy” that “can grow only by individual learning without a comparison means with other users.” See present specification at page 1, line 8 to page 2, line 2.

In the telephonic interview conducted on August 19, 2005, the Examiner asserted that Olaffson is directed to “games.” However, it is respectfully noted that Olaffson is directed to “user selection of service provision on a network of heterogeneous servers” that are “modeled by competitive replicator dynamics” and it is respectfully submitted that the “game” to which the Examiner refers is a hypothetical “evolutionary game theory” that allows the author to analyze

the selection, by “user agents,” of network resources provided by “network agents.” See Olaffson at pg. 1556, left column, first sentence and right column, first paragraph. Therefore, it is respectfully submitted that the “game” taught by Olaffson is in no way related to “video games” or “cyber characters” and that the “user agents” taught by Olaffson are in no way related to the “user” of a “video game” or “computerized toy.”

It is respectfully submitted that Olaffson has no applicability to the “computerized toys” of Gabai, the “children’s play and learning” of Nakamura, the “a cyber- character system” of Yang nor the computerized toy, cyber community, cyber character or user of a toy recited by the claims of the present invention. It is further respectfully submitted that Olaffson is **not** from the same field of endeavor as the Gabai, Nakamura or Yang references nor the same field of endeavor as the present invention, nor reasonably pertinent to the particular problem with which the Gabai, Nakamura and Yang inventors were involved nor reasonably pertinent to the particular problem with which the present inventor was involved.

Since the Examiner has failed to satisfy either of the In re Deminski criteria for determining whether prior art is analogous, it is respectfully asserted that the combination of Olaffson with Gabai, Nakamura and Yang is not proper. It is, therefore, respectfully requested that the rejection be withdrawn.

Second, it is respectfully submitted that the Examiner has not demonstrated the required motivation to combine Olaffson with Gabai, Nakamura and Yang. It is well-settled that a reference must provide some motivation or reason for one skilled in the art (working without the benefit of the applicants’ specification) to make the necessary changes in the disclosed device. The mere fact that a reference may be modified in the direction of the claimed invention does not make the modification obvious unless the reference expressly or impliedly teaches or suggests the desirability of the modification. In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984); Ex parte Clapp, 227 USPQ 972, 973 (Bd. App. 1985); Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. App. 1984). The Federal circuit has consistently held that hindsight reconstruction does not constitute a prima facie case of obviousness under 35 U.S.C. § 103. In re Geiger, 2 USPQ2d 1276 (Fed Cir. 1987).

It is respectfully noted that the only “strategies” taught by Olaffson are related to “options ... available to the user” or “resource-distribution strategies” for distributing “service requirements on the basis of their present understanding of the network utilities.” Page 1556,

right column. As previously respectfully submitted, the “users” or “user agents” of Olaffson have no relationship to the “users” of the “computerized toys” of Gabai, the “children” who use the “video games” of Nakamura nor the “users” of the “a cyber- character system” of Yang. It is further respectfully submitted that the “strategies” of Olaffson are not “a set of strategies” that could be applied to the “computerized toys” of Gabai, to the “autonomous characters” of Nakamura or to the “dog character in a mixed environment” of Yang.

It is respectfully submitted that the Examiner has not stated sufficient motivation found in Olaffson to modify Gabai, Nakamura and Yang as required by the courts in Gordon, Clapp, and Chicago Rawhide. It is respectfully asserted that the combination of the Gabai, Nakamura, Yang and Olaffson references fails to meet the basic requirement for a finding of obviousness since Olaffson is not analogous art and there is no suggestion in Olaffson of modifying the teachings of Gabai, Nakamura and Yang in the direction of the present invention, nor is there any suggestion whatsoever of the desirability of such modification. Therefore, it is further respectfully asserted that one of ordinary skill in the art would **not** have had the requisite motivation to modify the Gabai invention to provide the invention recited in claims 1-4, 7, 10 and 13 of the present invention and it is respectfully requested that the rejection be withdrawn.

#### 102(e) Rejection

It is respectfully noted that the Examiner indicates, at page 4 of the Office action, that Gabai “doesn’t explicitly teach the community is a cyber community and the character is a cyber character.” Applicant respectfully submits that it is unclear how Gabai can be asserted as anticipating the claims in view of the Examiner’s apparent indication that Gabai fails to disclose all of the recited limitations.

#### Prima Facie Obviousness

Although the Applicant believes the combination of references cited by the Examiner is improper, it is respectfully submitted that, even if the combination of cited references were asserted against the claims, prima facie obviousness is not established.

It is respectfully noted that the Examiner asserted a combination multiple references with respect to independent claims 1 and 13 and that the individual references are asserted as



anticipating portions of each claim limitation. Therefore, each independent claim will be discussed individually, with each limitation individually evaluated.

It is respectfully noted that the Federal Circuit has provided that an Examiner must establish a case of prima facie obviousness. Otherwise the rejection is incorrect and must be overturned. As the court recently stated in In re Rijkaert, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993):

“In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. ‘A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.’ If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned.” (citations omitted.)

#### Claim 1

It is respectfully noted that the Examiner indicates, at page 4 of the Office action, that Gabai “doesn’t explicitly teach the community is a cyber community and the character is a cyber character.” It is further respectfully noted that the Examiner asserts various portions of Gabai in combination as disclosing the recited cyber community having a cyber character which grows by learning online. However, it is further respectfully noted that the Examiner does not assert any single portion as disclosing the recited cyber community, cyber character and learning online, but instead asserts that paragraph 292 (col. 54, ll. 44-49) discloses a “community having a character” and that paragraphs 341-344 (col. 60, ll. 39-67) disclose “learning online.” It is respectfully submitted that there is not sufficient correspondence between the disclosure of “a community having a character” in one portion of Gabai and the disclosure of “learning online” in another portion of Gabai to disclose a cyber community having a cyber character which grows by learning online, given that the limitation requires that the “character” is a cyber character in a cyber community and the cyber character must grow by learning online.

It is respectfully noted that the “character” to which the Examiner refers is disclosed as being from a “movie, play [or] television show” and not disclosed as a cyber character, nor is the “character” disclosed as part of a cyber community. Col. 54, ll. 44-46. It is further respectfully

noted that the “character” to which the Examiner refers is not disclosed as growing by learning online, but rather is disclosed as “act[ing] out, possibly interactive, scenes.” Col. 54, ll. 46-49. Moreover, it is respectfully noted that the “learning” to which the Examiner refers is not disclosed as performed by a cyber character, but rather is disclosed as performed by “toys” that “serve a useful educational function by teaching users.” Col. 60, ll. 46-51. Therefore, it is respectfully submitted that the portions of Gabai to which the Examiner refers disclose “movie, play [or] television show” characters that “act out, possibly interactive, scenes” and “toys” that “learn” online and “teach users” as opposed to a cyber character in a cyber community grows by learning online.

It is further respectfully noted that the Examiner, at page 4 of the Office action, asserts that the abstract of Nakamura discloses a “cyber community,” the abstract Yang discloses a “cyber character” and Olaffson discloses, at the right column, paragraph 1 of page 1557, “growth” and, at the left column, paragraph 3 of page 1557, “by learning”. However, it is further respectfully noted that the Examiner does not assert any single portion of Nakamura, Yang or Olaffson as disclosing the recited cyber community, cyber character and learning online.

With respect to Nakamura, it is respectfully noted that no “cyber character” is disclosed and the only “learning” that is disclosed is performed by “users” of “video games” as opposed to learning online performed by a cyber character. Abstract. With regard to Yang, it is respectfully noted that no “learning” is disclosed and, any inherent “learning” is performed by the “users” who are provided with “a realistic feeling of the artificial life” as opposed to learning online performed by a cyber character. Abstract. With respect to Olaffson, notwithstanding that the reference is non-analogous art, it is respectfully noted that “growth” is disclosed with respect to “growth rates” of the “market share” of a “service provider” and “learning” is disclosed as performed by “user agents” based on “using the network services” and, therefore, neither disclosure is related to learning online by a cyber character in a cyber community. Left column, paragraph 3 and right column, paragraph 1 of page 1557. It is respectfully submitted that it would **not** be obvious to a person of ordinary skill in the art to modify the “character” of Gabai to be a cyber character that is part of a cyber community nor to modify the “learning” performed by the “toys” of Gabai to be performed by a cyber character.

In view of the above arguments, it is respectfully asserted that the Examiner has failed to establish a prima facie case of obviousness and, therefore, independent claim 1 is allowable over

the cited references. It is further respectfully asserted that claims 2-4, 7 and 10, which depend from claim 1, also are allowable over the cited references.

### Claim 13

With this paper, independent claim 13 has been amended to more clearly disclose the invention. Support for the amendments may be found in the specification as originally filed at page 5, ll. 1-6. It is respectfully noted that the Examiner indicates, at page 8 of the Office action, that Gabai “doesn’t explicitly teach the community is a cyber community and the character is a cyber character.”

It is respectfully noted that the Examiner asserts various portions of Gabai in combination as disclosing the recited activity of the cyber character in the cyber community reflect the experience information by transmitting the experience information to the network server. However, it is further respectfully noted that the Examiner does not assert any single portion as disclosing the recited cyber character, cyber community and transmitting the experience information to the network server, but instead asserts that paragraph 292 (col. 54, 11.44-49) discloses a “activity of the character in the community” and that paragraph 79 (col. 24, ll. 20-25), paragraphs 150-154 (col. 34, line 20 to col. 35, line 3), paragraph 305 (col. 56, ll. 12-29) and Fig. 46 disclose “transmitting the experience information to a network server.” Moreover, it is respectfully noted that the Examiner does not appear to refer to any particular portion of Gabai as disclosing “reflect the experience information.” It is respectfully submitted that there is not sufficient correspondence between the disclosure of “activity of the character in the community” in one portion of Gabai and the disclosure of “transmitting the experience information to a network server” in another portion of Gabai to disclose activity of the cyber character in the cyber community reflect the experience information by transmitting the experience information to the network server, given that the limitation requires that the “character” is a cyber character in a cyber community that reflects the experience information and the experience information that is reflected by the cyber character and transmitted to the network server is experience information that was obtained by the toy.

As was previously respectfully submitted, paragraph 292 (col. col. 54, 11.44-49) to which the Examiner referred with regard to the rejection of claim 1, discloses a “character” that is neither a cyber character nor part of a cyber community. It is further respectfully submitted that

paragraph 292 does not disclose any experience information at all. Moreover, it is respectfully submitted that paragraph 79 (col. 24, ll. 20-25), paragraphs 150-154 (col. 34, line 20 to col. 35, line 3), paragraph 305 (col. 56, ll. 12-29) and Fig. 46 also do not disclose experience information that is obtained by a toy and reflected in the activity of a cyber character in a cyber community.

It is respectfully noted that the “experience of all the toys” disclosed at col. 24, ll. 20-25 reflects the “user’s likes and dislikes” and is used to determine “trends in sales and marketing techniques.” It is further respectfully noted that col. 34, line 20 to col. 35, line 3 discloses “an integrated living experience” of toys, a “database of user experiences” with toys, a “living experience” provided by a system and “information” about the position of a controller. It is further respectfully noted that the “experiences” obtained by the toys that are disclosed at col. 56, ll. 12-29, are not disclosed as being “transmitted” or “reflected.” Moreover, it is respectfully noted that FIG. 46 “shows two examples of how an integrated entertainment and home automation system is connected to a controlling computer” and “allows transmission of both speech and nonverbal control of a toy.” Col. 34, ll.49-51 and col. 35, ll. 4-6. It is respectfully submitted that none of the aforementioned disclosure is sufficient to disclose activity of the cyber character in the cyber community reflect the experience information by transmitting the experience information to the network server.

As was done with respect to the rejection of claim 1, the Examiner, at page 8 of the Office action, asserts that the abstract of Nakamura discloses a “cyber community” and the abstract Yang discloses a “cyber character.” As was previously done with respect to the rejection of claim 1, it is respectfully submitted that the teachings of Nakamura and Yang would **not** motivate a person of ordinary skill in the art to modify the “character” of Gabai to be a cyber character that is part of a cyber community.

It is respectfully noted that the Examiner asserts various portions of Gabai in combination as disclosing the recited toy learning by transmitting experience information according to the activity of the cyber character in the cyber community. However, it is further respectfully noted that the Examiner does not assert any single portion as disclosing the recited toy learning, activity of the cyber character, cyber community and transmitting the experience information, but instead asserts that paragraph 317 (col. 57, ll. 58-64) discloses “having the toy learn” and that paragraph 342 (col. 60, ll. 46-48) and Fig. 46 disclose “transmitting the experience information according to the activity of the character in the community.” It is respectfully submitted that

there is not sufficient correspondence between the disclosure of “having the toy learn” in one portion of Gabai and the disclosure of disclose “transmitting the experience information according to the activity of the character in the community” in another portion of Gabai to disclose having the toy learn by transmitting the experience information according to the activity of the cyber character in the cyber community, given that the limitation, as amended by this paper, requires that the “character” is a cyber character in a cyber community and the experience information is according to the activity of the cyber character and is transmitted from the network server to the toy.

It is respectfully noted that the disclosure at paragraph 317 (col. 57, ll. 58-64), it is not of a “toy” that “learns,” but rather that the “user learns much more willingly from his own toy which ... may represent a popular mouse character” and it is respectfully submitted that there is no disclosure of any “transmitting” information “from a network server to the toy.” See also col. 54, ll. 46-48. It is further respectfully noted that the “learning” by “toys” disclosed at paragraph 342 (col. 60, ll. 46-48) is not “according to the activity of a cyber character” but rather of “known features of the user as derived from its database.” See also col. 60, ll. 33-35. Moreover, as previously noted, FIG. 46 “shows two examples of how an integrated entertainment and home automation system is connected to a controlling computer” and “allows transmission of both speech and nonverbal control of a toy” but does not disclose any information according to the activity of a cyber character.” It is respectfully submitted that none of the aforementioned disclosure is sufficient to disclose toy learning by transmitting experience information according to the activity of a cyber character in a cyber community.

As previously submitted with respect to the rejection of claim 1, the teachings of Nakamura and Yang would **not** motivate a person of ordinary skill in the art to modify the “character” of Gabai to be a cyber character that is part of a cyber community.

In view of the above arguments, it is respectfully asserted that the Examiner has failed to establish a prima facie case of obviousness and, therefore, independent claim 13 is allowable over the cited references.

Claims 5 and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gabai in view of Nakamura in view of Yang in view of Olafsson and in further view of Okada et al. (“Okada” U.S. Pat. No. 6,609,968). This rejection is respectfully traversed.

As was previously respectfully asserted, the combination of the Gabai, Nakamura, Yang, and Olaffson references is improper and, even if the references are asserted, independent claim 1 is allowable over the cited references. It is respectfully submitted that Okada fails to overcome the deficiencies of the Gabai, Nakamura, Yang and Olaffson references.

Therefore, it is respectfully asserted that independent claim 1 is allowable over the cited references. It is further respectfully asserted that claims 5 and 9, which depend from claim 1, also allowable over the cited references.

Claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Gabai in view of Nakamura in view of Yang in view of Olaffson and further in view of Brown (U.S. Pat. No. 6,210,272). This rejection is respectfully traversed.

As was previously respectfully asserted, the combination of the Gabai, Nakamura, Yang and Olaffson references is improper and, even if the references are asserted, independent claim 1 is allowable over the cited references. It is respectfully submitted that Brown fails to overcome the deficiencies of the Gabai, Nakamura, Yang and Olaffson references.

Therefore, it is respectfully asserted that independent claim 1 is allowable over the cited references. It is further respectfully asserted that claim 6, which depends from claim 1, also is allowable over the cited references.

Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Gabai in view of Nakamura in view of Olaffson and further in view of Bushmitch, et al. ("Bushmitch" U.S. Pat. No. 6,494,762). This rejection is respectfully traversed.

As was previously respectfully asserted, the combination of the Gabai, Nakamura, Yang, and Olaffson references is improper and, even if the references are asserted, independent claim 1 is allowable over the cited references. It is respectfully submitted that Bushmitch fails to overcome the deficiencies of the Gabai, Nakamura, Yang, and Olaffson references.

Therefore, it is respectfully asserted that independent claim 1 is allowable over the cited references. It is further respectfully asserted that claim 8, which depends from claim 1, also is allowable over the cited references.

Claims 11, 12 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gabai in view of Nakamura in view of Yang in view of Olaffson and in further view of Yokoo et al. ("Yokoo" U.S. Pat. No. 6,449,518). This rejection is respectfully traversed.

As was previously respectfully asserted, the combination of the Gabai, Nakamura, Yang, and Olaffson references is improper and, even if the references are asserted, independent claims 1 and 13 are allowable over the cited references. It is respectfully submitted that Yokoo fails to overcome the deficiencies of the Gabai, Nakamura, Yang and Olaffson references.

Therefore, it is respectfully asserted that independent claims 1 and 13 are allowable over the cited references. It is further respectfully asserted that claims 11 and 12, which depend from claim 1, and claim 17, which depends from claim 13, also are allowable over the cited references.

Claims 14 and 15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gabai in view of Nakamura in view of Yang in view of Olaffson and further in view of Faris et al. ("Faris" U.S. Pat. No. 6,659,861). This rejection is respectfully traversed.

As was previously respectfully asserted, the combination of the Gabai, Nakamura, Yang and Olaffson references is improper and, even if the references are asserted, independent claim 13 is allowable over the cited references. It is respectfully submitted that Faris fails to overcome the deficiencies of the Gabai, Nakamura, Yang and Olaffson references.

Therefore, it is respectfully asserted that independent claim 13 is allowable over the cited references. It is further respectfully asserted that claims 14 and 15, which depend from claim 13, also are allowable over the cited references.

Claim 16 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Gabai in view of Nakamura in view of Yang in view of Olaffson in view of Faris and further in view of Gechter (U.S. Pat. No. 5,498,002). This rejection is respectfully traversed.

As was previously respectfully asserted, the combination of the Gabai, Nakamura, Yang and Olaffson references is improper and, even if the references are asserted, independent claim 1 is allowable over the cited references. It is respectfully submitted that Faris and Gechter fail to overcome the deficiencies of the Gabai, Nakamura, Yang and Olaffson references.

Therefore, it is respectfully asserted that independent claim 13 is allowable over the cited references. It is further respectfully asserted that claim 16, which depends from claim 13, also is allowable over the cited references.

Claim 18 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Gabai in view of Nakamura in view of Yang in view of Olaffson in view of Hornsby et al. ("Hornsby" U.S. Pat. No. 6,527,610) in view of Hawkins et al. ("Hawkins" U.S. Patent No. 6,009,458) and

further in view of Feigenbaum et al. (“Feigenbaum” “The Hard book of Artificial Intelligence Volume 1” (1989)). This rejection is respectfully traversed.

Combination of Olaffson and Feigenbaum with Gabai, Nakamura, Yang Hornsby and Hawkins references is Improper

The Examiner asserted in the Office action, at page 26 that the Gabai invention modified by the teachings of Nakamura, Yang, Olaffson, Hornsby, Hawkins and Feigenbaum renders the claimed invention obvious. The Examiner further asserts that the motivation to modify Gabai, Yang, Nakamura, Hornsby and Hawkins by the teachings of Olaffson and Feigenbaum is “applying a set of strategies (Olaffson, page 1556, section I, paragraph 2)” and “specifying appropriate methods that can take advantage of the current context” (Feigenbaum, page 320, paragraph 1) to direct “autonomous characters (Nakamura)” to interact “with a dog character in a mixed environment (Yang)” by “controlling the images displayed and other operational parameters of the video and/or audio displays” (Hornsby, paragraph 20) and viewing, mapping, or simply selecting playing objects (Hawkins, paragraph 246). Applicant respectfully disagrees with the Examiner’s interpretation of Olaffson and Feigenbaum and respectfully asserts that the combination of references is not proper.

First, as was respectfully submitted with respect to the rejection of claims 1-4, 7, 10 and 13, the Olaffson reference is directed to non-analogous art. It is further respectfully submitted that the Feigenbaum reference is also directed to non-analogous art. Moreover, it is further respectfully submitted that Feigenbaum has no relationship to a computerized toy, cyber community, cyber character or user of a toy, as recited in the claims of the present application.

As was previously respectfully noted, Gabai is directed to “computerized toys” and, specifically, to allowing “toy owners who do not have available a personal or other local computers to operate interactive toys.” As was previously further respectfully noted, Nakamura is directed to “video games” and, specifically, to “children’s play and learning” by using “games and toys” as “communication tools.” As was previously respectfully noted, Yang is directed to “cyber characters ... inhabiting a virtual world” and, specifically, to “a cyber- character system designed to provide users with a realistic feeling of an artificial life.” As was previously respectfully noted, the present invention is directed to “a toy learning apparatus using a cyber community” and, specifically, to the disadvantages of a conventional computerized “intelligent



toy” that “can grow only by individual learning without a comparison means with other users.” See present specification at page 1, line 8 to page 2, line 2.

It is respectfully noted that Hornsby is directed to “an electronic, substantially digital, interactive amusement device designed to be worn or carried by a user” and, specifically, to “an amusement device which increases the appeal and interactivity ... without additional input from the user.” Col. 1, ll. 10-13 and 57-61. It is further respectfully noted that Hawkins is directed to “computer game systems” and, specifically, to “the mapping of playing objects from one game to another.” Col. 1, ll. 7-11 and col. 2, ll. 65-66.

On the other hand, it is respectfully noted that the Feigenbaum reference is directed to the way that “people use a large, well-coordinated body of knowledge from previous experiences to interpret new situations in their everyday cognitive activity” and, specifically, to “the AI knowledge-representation ideas called frames and scripts.” Page 216, first paragraph. It is respectfully submitted that the “frames and scripts” taught by Feigenbaum are in no way related to “video games,” “cyber characters,” “computerized toys,” an “electronic, substantially digital, interactive amusement device” or “computer game systems.”

As was previously is respectfully submitted with respect to the rejection of claims 1-4, 7, 10 and 13, Olafsson has no applicability to the “computerized toys” of Gabai, the “children’s play and learning” of Nakamura, the “a cyber- character system designed to provide users with a realistic feeling of an artificial life” of Yang nor the computerized toy, cyber community, cyber character or user of a toy recited by the claims of the present invention. As was further respectfully submitted with respect to the rejection of claims 1-4, 7, 10 and 13, Olafsson is **not** from the same field of endeavor as the Gabai, Nakamura or Yang references nor the same field of endeavor as the present invention, nor reasonably pertinent to the particular problem with which the Gabai, Nakamura and Yang inventors were involved nor reasonably pertinent to the particular problem with which the present inventor was involved.

It is respectfully submitted the Feigenbaum has no applicability to the “computerized toys” of Gabai, the “children’s play and learning” of Nakamura, the “a cyber- character system designed to provide users with a realistic feeling of an artificial life” of Yang, the “amusement device” of Hornsby, the “the mapping of playing objects from one game to another” of Hawkins nor the computerized toy, cyber community, cyber character or user of a toy recited by the claims of the present invention. It is further respectfully submitted that Feigenbaum is **not** from

the same field of endeavor as the Gabai, Nakamura, Yang, Hornsby and Hawkins references nor the same field of endeavor as the present invention, nor reasonably pertinent to the particular problem with which the Gabai, Nakamura, Yang, Hornsby and Hawkins inventors were involved nor reasonably pertinent to the particular problem with which the present inventor was involved.

Since the Examiner has failed to satisfy either of the In re Deminski criteria for determining whether prior art is analogous, it is respectfully asserted that the combination of Olaffson and Feigenbaum with Gabai, Nakamura, Yang, Hornsby and Hawkins is not proper. It is, therefore, respectfully requested that the rejection be withdrawn.

Second, as was respectfully submitted with respect to the rejection of claims 1-4, 7, 10 and 13, the Examiner has not demonstrated the required motivation to combine Olaffson with Gabai, Nakamura and Yang. It is further respectfully submitted that the Examiner has not demonstrated the required motivation to combine Feigenbaum with Gabai, Nakamura, Yang, Hornsby and Hawkins.

It is respectfully noted that the only “appropriate methods that can take advantage of the current context” taught by Feigenbaum are related to the way “people use ... previous experiences to interpret new situations in their everyday ... activity.” Page 216, first paragraph. It is respectfully submitted the way “people” who “use ... previous experiences to interpret new situations in their everyday ... activity” of Feigenbaum has no relationship to the “users” of the “computerized toys” of Gabai, the “children” who use the “video games” of Nakamura, the “users” of the “a cyber- character system” of Yang, the “amusement device” of Hornsby, nor the “game” of Hawkins. It is further respectfully submitted that the “appropriate methods” of Feigenbaum are not “methods” that could be applied to the “computerized toys” of Gabai, the “autonomous characters” of Nakamura, the “dog character in a mixed environment” of Yang, the “video and/or audio displays” of Hornsby, nor to the “playing objects of Hawkins.

It is respectfully submitted that the Examiner has not stated sufficient motivation found in Feigenbaum to modify Gabai, Nakamura, Yang, Hornsby and Hawkins as required by the courts in Gordon, Clapp, and Chicago Rawhide. It is respectfully asserted that the combination of the Gabai, Nakamura, Yang, Olaffson, Hornsby, Hawkins and Feigenbaum references fails to meet the basic requirement for a finding of obviousness since both Olaffson and Feigenbaum are not analogous art and there is no suggestion in either Olaffson or Feigenbaum of modifying the teachings of Gabai, Nakamura, Yang, Hornsby and Hawkins in the direction of the present

invention, nor is there any suggestion whatsoever of the desirability of such modification. Therefore, it is further respectfully asserted that one of ordinary skill in the art would not have had the requisite motivation to modify the Gabai invention to provide the invention recited in claim 18 of the present invention and it is respectfully requested that the rejection be withdrawn.

#### Prima Facie Obviousness

Although the Applicant believes the combination of references cited by the Examiner is improper, it is respectfully submitted that, even if the combination of cited references were asserted against the claims, prima facie obviousness is not established.

With this paper, claim 18 has been amended to more clearly disclose the invention. Support for the amendment may be found in the specification as originally filed at page 9, ll. 1-8. It is respectfully noted that the Examiner asserted a combination multiple references with respect to claim 18 and that the individual references are asserted as anticipating portions of each claim limitation. Therefore, each limitation will be individually evaluated.

It is respectfully noted that the Examiner indicates, at page 25 of the Office action that Gabai “doesn’t explicitly teach the community is a cyber community, the character is a cyber character, selecting a user mode to identify the user of the toy and selecting a default user if the user mode is not selected.” It is further respectfully noted that the Examiner asserts various portions of Gabai in combination as disclosing the recited experience information of the toy reflected on a cyber character in an online community according to the selected user and changing the activity of the cyber community according to the experience information and the selected user. Moreover, it is further respectfully noted that the Examiner does not assert any single portion as disclosing the recited cyber character, cyber community, experience information and selected user, but instead asserts that paragraph 271 (col. 52, ll. 8-18) discloses “reflecting experience information” of the toy, paragraph 292 (col. 54, ll. 44-49) discloses a “on a character,” paragraphs 341-344 (col. 60, ll. 19-67) disclose “online,” paragraph 89 (col. 25, line 56, to col. 26, line 9) discloses “community,” paragraph 199 (col. 43, ll. 53-65) discloses “according to the selected user” and paragraph 303 (col. 55, line 63, to col. 56, line 3) discloses “changing the activity of the community” according to experience information of the selected user.

It is respectfully submitted that there is not sufficient correspondence between the disclosure of “reflecting experience information” in one portion of Gabai, the disclosure of “on a character” in another portion of Gabai, the disclosure of “online” in another portion of Gabai, the disclosure of “community” in another portion of Gabai, and the disclosure of “changing the activity of the community” in another portion of Gabai to disclose experience information of the toy reflected on a cyber character in an online community and changing the activity of the cyber community according to the experience information, given that the limitation requires that the “character” is a cyber character in a cyber community that reflects the experience information and the experience information that is reflected by the cyber character is experience information that was obtained by the toy.

As was previously respectfully submitted, paragraph 292 (col. 54, ll. 44-49) to which the Examiner referred with regard to the rejection of claims 1 and 13, discloses a “character” that is neither a cyber character nor part of a cyber community. As was also previously respectfully submitted, paragraph 292 does not disclose any experience information at all. Moreover, it is respectfully submitted that paragraph 271 (col. 52, ll. 8-18) discloses “information” from a toy “may be added to a server’s database” but not that “information” is reflected on a cyber character or a cyber community.

It is respectfully noted that the disclosure at paragraph 199 (col. 43, ll. 53-68) is that “an interactive toy” provides “information” to a “user” according to “user-specific requirements” or, in other words, “selection by a user” rather than a selected user determines information that is provided to the “user” rather than to a cyber community. It is further respectfully noted that paragraph 303 (col. 55, line 63, to col. 56, line 3) discloses that “[l]anguage barriers may be overcome” in “interactive gaming” by using “computerized translations” or “toys as the medium” for a “new form of communication.” It is respectfully submitted that paragraph 303 does not disclose obtaining experience information or changing activity of a cyber character or a cyber community according to any selected user. It is further respectfully submitted that the Examiner’s own indication that “Gabai doesn’t explicitly teach ... selecting a user mode to identify the user” contradicts the assertions with regard to paragraphs 199 and 303.

It is respectfully noted that the Examiner asserts various portions of Gabai in combination as disclosing the recited reflecting the experience of the cyber character in the online cyber community on a current status of the toy and changing the action of the toy. However, it is

further respectfully noted that the Examiner does not assert any single portion as disclosing the recited activity of the cyber character, cyber community, status of the toy and changing the action of the toy, but instead asserts that paragraphs 150-151 (col. 34, line 20, to col. 35, line 3) discloses “reflecting the experience information of the character in the online community,” paragraph 293 (col. 54, ll. 50-60) discloses “on a current status of the toy” and paragraphs 397-398 (col. 67, ll. 43-59) disclose “changing the action of the toy.” It is respectfully submitted that there is not sufficient correspondence between the asserted disclosure of “reflecting the experience information of the character in the online community” in one portion of Gabai, the asserted disclosure of “on the current status of the toy” in another portion of Gabai and the asserted disclosure of “changing the action of the toy” in another portion of Gabai to disclose reflecting the experience of the cyber character in the online cyber community on a current status of the toy and changing the action of the toy, given that the limitation, as amended, requires that the “character” is a cyber character in a cyber community and the action of the toy is changed according to the experience of the cyber character.

As was previously respectfully noted, paragraph 150-151(col. 34, line 20, to col. 35, line 3) to which the Examiner referred with regard to the rejection of claim 13, discloses “an integrated living experience” of toys, a “database of user experiences” with toys, a “living experience” provided by a system and “information” about the position of a controller. It is respectfully submitted that information related to the “toy” or the “user” is disclosed rather than the experience of a cyber character in a cyber community.

It is respectfully noted that the disclosure at paragraph 293 (col. 54, ll. 50-60) is that “response of one of more users affect the progress of the play” that is “done online” by changing “the scene.” It is respectfully submitted that the disclosure is that the current status of a “cyber” play is changed to reflect the experience of “users” by changing a “scene” rather than that the status of a toy is changed to reflect the experience of a cyber character by changing the action of the toy. It is further respectfully noted that the disclosure at paragraphs 397-398 (col. 67, ll. 43-59) is that “an interactive toy” may be controlled via a “controller” and it is further respectfully submitted that there is no disclosure that the control is according to the experience of a cyber character.

It is further respectfully noted that the Examiner, at page 25 of the Office action, asserts that the abstract of Nakamura discloses a “cyber community” and the abstract Yang discloses a

“cyber character.” As was previously submitted with respect to the rejection of claims 1 and 13, the teachings of Nakamura and Yang would **not** motivate a person of ordinary skill in the art to modify the “character” of Gabai to be a cyber character that is part of a cyber community.

It is respectfully noted that the Examiner, at page 25 of the Office action, asserts that Olaffson discloses, at the right column, paragraph 1 of page 1557, “selecting a user mode” and, at section I, paragraph 1 of page 1556, “to identify the user of the toy.” However, it is further respectfully noted that the Examiner does not assert any single portion of Olaffson as disclosing the recited selecting a user mode to identify the user of the toy. Moreover, it is respectfully noted that the Examiner asserted, in the telephonic interview conducted on August 19, 2005, that a “toy” is inherent in the “game” of Olaffson.

Notwithstanding that the Olaffson reference is non-analogous art, it is respectfully noted that the “service selection” disclosed at the right column, paragraph 1 of page 1557 of Olaffson is related to a “user” selecting a “service provider” based on “replicator dynamics” as opposed to “selecting a user mode.” It is further respectfully noted that the “identity” disclosed at section I, paragraph 1 of page 1556 of Olaffson is related to “network resources” provided by a “service provider” as opposed to the “identity of the user of a “toy.” Moreover, as was previously respectfully noted with regard to the rejection of claim 1, the “game” to which the Examiner refers is a hypothetical “evolutionary game theory.” It is respectfully submitted that there is no “toy” inherent in a hypothetical “evolutionary game theory.”

It is further respectfully noted that the Examiner, at page 26 of the Office action, asserts that paragraph 2 of the section titled Procedural Knowledge in Frames and Scripts on page 219 of Feigenbaum discloses a “selecting a default user.” It is respectfully noted that the disclosure at page 219 of Feigenbaum is that a “default restaurant type can be used.” It is respectfully submitted that the disclosure of a “default restaurant type” as a means for evaluating the “expectations based on experience in other restaurants” that a person might have when they “visit a restaurant where we have never been before” is not sufficient to disclose selecting a default user of a toy. See also page 216, first paragraph.

In view of the above arguments, it is respectfully asserted that the Examiner has failed to establish a prima facie case of obviousness and, therefore, independent claim 18 is allowable over the cited references

### CONCLUSION

In light of the above remarks, Applicant submits that claims 1-18 of the present application are in condition for allowance. Reexamination and reconsideration of the application, as amended, are requested.

The Examiner has cited multiple references as being made of record and not relied upon. Applicant has studied the references and believes they neither anticipate nor render obvious the present invention either alone or in combination.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.


If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California telephone number (213) 623-2221 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

LEE, HONG, DEGERMAN, KANG &  
SCHMADEKA

Date: September 9, 2005

Encl: Substitute FIG. 5

By:   
Lew Edward V. Maeapagal  
Registration No. 55,416  
Attorney for Applicant

Customer No. 035884

801 S. Figueroa Street, 14<sup>th</sup> Floor  
Los Angeles, California 90017  
Telephone: 213-623-2221  
Facsimile: 213-623-2211